REMARKS

Claims 1-42 and 46-66 are canceled. Claims 43-45, and 67-87 were previously presented. New claims 88-90 are added. Accordingly, claims 43-45, and 67-87 are pending examination.

Rejection of Claim 43 Under 35 USC §103

Claims 43 stands rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,399,242 (Kitoh) and U.S. Patent No. 3,159,508 (Chreitzberg).

1. MPEP 2144.04(VI)(C) does not apply

The pending rejection relies at least partly on the case of In re. Japiske, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). This case is cited in MPEP 2144.04(VI)(C). The heading of MPEP 2144.04(VI)(C) is "*Rearrangement of Parts.*" Accordingly, this portion of the MPEP is directed to the law for rejections based on an argument that an Applicant has merely re-arranged parts of a prior art device.

The entire text of MPEP 2144.04(VI)(C) appears as follows:

C. Rearrangement of Parts

In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device **was held to be an obvious matter of design choice**). However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte*

Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). (Underlining and bolded sections added by Applicant)

As is evident from the bolded portion of the text this section of the MPEP(VI)(C) applies when the "rearrangement or parts" is a matter of design choice.

The location of the tab recited in the claim 43 is not a mere matter of design choice. For instance, as stated in the specification, the claimed tab location can **"obviate... the need for a separate electrolyte fill port, thereby reducing the number of components and number of seals to be made, thus reducing cost and improving reliability."** The specification describes this as follows:

> In accordance with a preferred embodiment, the tab 94 is sufficiently long to locate the weld 110 beyond the center point of the circular endcap 114. More particularly, note in FIGS. 21-24 that by locating the weld 110 displaced from the center of the cap 114, the tab 94 can conveniently support the endcap 114 in a vertical orientation as depicted in FIG. 22 misaligned with respect to the open end 106. This end cap position approximately perpendicular to the end 122 of the case 100 is a first bias position wherein the end cap advantageously tends to remain in that orientation with the case end open prior to filling. To further describe the relationship between the weld location and the various components, FIG. 23 shows a front view with various dimensions. L represents the length from the weld 110 to the top of the case 100 as measured parallel to the edge of the case. R is the radius of the end cap 114. For the preferred geometry, $L \leq 2R$. Weld 110 is preferably made above the center point 111 of the end cap 114. Preferably, the end cap 114 overlaps the case 100 by approximately R/2. By configuring the tab 94 and weld 110 as indicated, the endcap 114 can be supported so that it does not obstruct the open end 106, thereby facilitating electrolyte filling of the case interior cavity via open end 106. A filling needle or nozzle can be placed through open end 106 to fill the case. **This obviates the need for a separate electrolyte fill port, thereby reducing the number of components and number of seals to be made, thus reducing cost and improving reliability.**

> Furthermore, for small medical batteries, the end caps would be very small to have fill ports therein. In a preferred embodiment in which the case wall is very thin, for example, 0.002 inches, providing a fill port in the side wall of the case would be impractical. Even in the case of larger devices where space is less critical and the wall is more substantial, providing a fill port in the side of the case would mean the electrolyte would have a very long path length to wet the jellyroll. Note that while the case could be filled with electrolyte prior to welding tab 94 to endcap 114, it would be difficult and messy to do so. Therefore, it is advantageous to configure the tab 94 and weld 110 as described to allow the weld to be made prior to filling.

Since the claimed tab location can "**obviate... the need for a separate electrolyte fill port, thereby reducing the number of components and number of seals to be made, thus reducing cost and improving reliability,**" there is no reasonable argument that this is a mere design choice. Since the claimed tab location is not a mere matter of design choice shows that MPEP(VI)(C) is not properly applied to this rejection.

Additionally, the portion of MPEP(VI)(C) that that Applicant underlined above states that "(t)he prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." The motivation set forth in the Office Action is that the proposed modification would "reduce internal resistance and facilitate current extraction." Nothing in any of the cited art indicates that making the suggest modification would reduce internal resistance or improve "current extraction." Since the motivations for the proposed modification cannot be found in the cited art as is required for the proper application of MPEP(VI)(C), this section of the MPEP is not properly applied to this rejection.

2. There Is No Motivation to Make the Proposed Modification

The Office Action proposes attaching Kitoh's tabs as taught by Chreitzberg's. The Office Action states that the motivation for the proposed modification is to "reduce internal resistance and facilitate current extraction."

The Office Action analogizes Chreitzberg's conductors 8, 11 to the claimed tab. However, the ONLY teachings that Chreitzberg provides about these conductors 8, 11 are shown in Figure 1 and in the following text:

> Each of the negative electrodes 3 is connected to the negative terminal of the battery 7 by means of a conductor 8. Similarly, each of the positive electrodes 4 is connected to the positive terminal of the battery 9 by means of a conductor 11.

There is nothing about these teachings that even suggests that the arrangement of the Chreitzberg's conductors 8, 11 would "reduce internal resistance and facilitate current extraction" in Itoh's battery. As a result, the motivation for the proposed modification cannot be found in the cited art.

The KSR decision finds that the motivation for a proposed modification can also come from common sense. However, common sense indicates that the stated motivation is not accurate. For instance, since Itoh's tabs are shown positioned in one half of the battery, modifying Itoh as proposed would lengthen Itoh's tabs. Increasing the length of a tab increases the resistance provided by that tab and accordingly increases the internal resistance of the battery. Further, increasing the internal resistance of the battery cannot be considered to facilitate current extraction. As a result, common sense does not lead one to conclude that re-locating Itoh's tabs as suggested would "reduce internal resistance and facilitate current extraction."

Due to the lack of reasoning for the stated motivation in either the cited art or in common sense, the only motivation for the proposed modification appears to be found in the Applicant's specification. As a result, it logically follows that the basis for the proposed modification has been improperly gleaned from Applicant's own specification and that the combination of the cited is an exercise of impermissible hindsight. Accordingly, it is respectfully submitted that the combination is improper and respectfully requested that the rejection be withdrawn.

3. The Cited Art Does Not Teach or Suggest Every Limitation of the Claims

Itoh teaches a battery having a single terminal 15 centered in each one of its endcaps. In order for Itoh to be modified so it includes all of the limitations of claim 43, one of Kitoh's terminals must be moved from its current location to a location that is off

center in the cap. Chreitzberg teaches multiple terminals extending through a single top seal 2. Since multiple terminals extend through a single "top seal 2," at least one of the terminals must be off center relative in the "top seal." There is nothing about multiple terminals extending through a single cap that suggests that Kitoh's centered terminal be moved to an off-center location. This is even more true when it is realized the Kitoh's terminal is centered relative to Kitoh's tabs and moving the terminal would disrupt this arrangement. As a result, the cited art does not teach or suggest all of the limitations of claim 43.

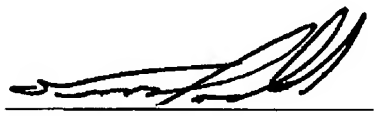
Rejection of claims 44-45, and 67-87

Claims 44-45, and 67-87 each depends directly or indirectly from independent claim 43. Since claim 43 is believed to be in condition for allowance, these claims are also believed to be in condition for allowance.

CONCLUSION

Applicant submits that the claims define patentably over the prior art and that this application is in condition for allowance. Accordingly, favorable consideration and allowance of this application is courteously requested.

The Examiner is encouraged to telephone the undersigned with any questions.



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